

REMARKS

Claims 1-20 are pending in the application. Claims 15-20, which were previously withdrawn from consideration, are canceled without prejudice or disclaimer. New Claims 21-24 are submitted for consideration. The specification and Claims 2 and 4 provide full support for new Claims 21-24. No new matter has been added. Claims 1 and 11 have been amended to more clearly define the invention. Reconsideration and allowance of the above referenced application is respectfully requested.

Responsive to the Examiner's request that the references listed in the specification be identified in an Information Disclosure Statement, Applicants submit that those references were properly submitted in an Information Disclosure Statement on July 26, 2002 and considered by the Examiner on September 7, 2004, as evidenced by the initialed and returned PTO 1449 attached to the present Official Action.

Rejections Under 35 U.S.C. § 112

Claims 1-14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In particular, the Examiner objects to Claim 1 because the preamble of the claim does not correlate with the body of the claim by reciting that a compound is identified. Applicants respectfully submit that by the above amendment to Claim 1, the rejection on that basis is rendered moot.

Further, the Examiner contends that Claim 1 omits an essential step of identifying the ligands that bind to the first and second binding sites. As the Examiner has observed, the specification, at lines 27-29 of page 20, teaches that the identification of sets of target binding

ligands is during the assembling steps currently recited in Claim 1. By the amendment to Claim 1, above, the included step of identifying is now expressly recited in Claim 1. Applicants respectfully submit that the rejection on that basis is now rendered moot.

The Examiner also contends that Claim 1 is vague and indefinite because it is unclear how Applicant is "linking the two bound members." Importantly, Claim 1 does not claim to link "the two bound members" as the Examiner's objection suggests. Claim 1, in pertinent part states, "assembling and identifying a first set of target binding ligands ..." and "assembling and identifying a second set of target binding ligands ..." and chemically linking at least one member of the first set and at least one member of the second set to provide a first set of linked ligands ...". The specification, in the paragraph bridging pages 20-21, clearly discloses that members of the first and second sets of target binding ligands can be chemically "...linked, e.g. coupled, fused or cross-linked, in a variety of combinations using one or more linker elements to provide a library of potential high affinity binding linked ligands ...". The specification continues on pages 21-23 to provide numerous non-limiting examples of such a linkage of target binding ligands. As such, Claim 1, is clear and understandable to one of ordinary skill in the art and is fully supported by the specification. Accordingly, Applicants request that the Examiner withdraw this basis for the rejection.

The Examiner also contends that the recitation "identify members" is vague and indefinite. As now claimed, by the above amendment to Claim 1, the step to "identify compound members" is clearly directed to the compounds identified in the preamble of Claim 1. Accordingly, Applicants assert that this basis for the present rejection is rendered moot.

The Examiner further contends that step (d) of Claim 1 is vague and indefinite because it is unclear how the ligand is screened. Throughout the specification Applicants disclose the use of mass spectroscopy as a means by which one of ordinary skill in the art would identify different

compounds with an expected high level of specificity. In particular, the Examiner is directed to the paragraph bridging pages 19-20 as an concise example of such use of this screening process. One of ordinary skill in the art, from a reading of the specification would understand the processes by which screening and identification of compounds throughout the process of the invention would be carried out. Applicants' therefore respectfully submit that the specification fully supports the invention as defined by Claim 1. Accordingly, withdrawal of this basis for the rejection is requested.

Responsive to the Examiner's objection to Claim 5, Applicants direct the Examiner's attention to the first full paragraph of page 25 of the specification, the complete reading of which will be instructive. As indicated in Claim 5 and made clear by Claim 6, in the method of Claim 1, the first binding site can be the same as the second binding site (Claim 5) or, as stated in Claim 6, the first binding site in Claim 1 is not the same as the second binding site. As such, the claims are clearly understood by one of ordinary skill in the art. Withdrawal of this basis for the rejection is respectfully requested.

Finally, the Examiner contends that the recitation "biological measurements" is vague and indefinite and without definition in the specification. By the above amendment to Claim 11, Applicants assert that this basis for the present rejection is rendered moot. Claim 11, as amended, is drawn to a screening step that comprises a "biological assay." This amendment is fully supported in the specification in the first full paragraph on page 40, which reads in part, "The molecules can then be assayed with the target, e.g., *in vivo*, *in vitro*, ELISA, or cell-based assay, to determine biological activity." By this amendment to Claim 11, this basis for the rejection is now overcome.

Having addressed each of the basis for rejection of the claims under 35 U.S.C. §112, second paragraph, Applicants respectfully request withdrawal of the present rejection.


CONCLUSION

In light of the above, Applicants believe that this application is now in condition for allowance and therefore requests favorable consideration.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

DLA PIPER RUDNICK GRAY CARY U.S. LLP


Steven B. Kelber
Registration No. 30,073
Attorney of Record

1200 Nineteenth Street, N.W.
Washington, D.C. 20036-2412
Telephone No. (202) 861-3900
Facsimile No. (202) 223-2085

Perry E. Van Over
Registration No. 42,197